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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,158	01/16/2002	Hiroki Ota	8003-1001	3700

466 7590 10/17/2003

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EXAMINER

JENKINS, DANIEL J

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 10/17/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,158

Applicant(s)

OTA ET AL.

Examiner

Daniel J. Jenkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The Examiner has carefully considered Applicant's Response of 7/17/03. The Examiner finds the arguments presented by Applicant not persuasive. In particular, the following arguments have been presented.

- The new limitation of "and a tensile strength of between 400 and 550 MPa" in claim 1 is not disclosed.
- The z value range of claim 1 is not disclosed.
- New claims 11-20 include a limitation to Ni of 0.01% to about 0.95%, whereas Kunio discloses a range of from 1% to 8%.

First, the Examiner finds that the tensile strength is not specifically disclosed per Example, as correctly argued by Applicant. However, the specific examples do not cover the entire range of component limitations, the Examiner finding that the range would be inherent as to the alloy formed of the selected components at the range limitations as disclosed.

Secondly, the Examiner agrees that the Examples of Kunio in Tables 1 and 2 do have Co of 2.4 or greater, but that the range of Co disclosed in Kunio is 0.5-7%. Additionally, the range of V is 0.001-0.5%, and the range of W is about 0.001 to about 0.05%, meeting the range of z.

Thirdly, the Examiner agrees that support exists by Example for a upper limitation to 0.95% Ni, and that this range is below 1-8% as disclosed by Kunio and not anticipated or obvious.

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2. Claims 11-20 are allowable, the prior art not teaching or suggesting lowering the Ni range to 0.01 to about 0.95%.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunio.

Kunio discloses a stainless Fe-C-Si based alloy comprising:

0.01-0.05% C;

0.05-1% Si;

0.05-2% Mn;

0.025% or less P;

0.01% or less S;

9-14% Cr;

3.1-7% Mo;

1-8% Ni;

0.5-7% Co;

0.001-0.1% Al;

0.05% or less N;

0.01% or less O;

0-5% Cu;

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0-5% W; and

remainder Fe and impurities (see Kunio claim 1 translation).


Kunio also teaches additions of elements selected from 0.001-0.5% V; 0.001-0.5% Nb; 0.001-0.5% Ti; 0.001-0.5% Zr (see Kunio claim 2 translation).

The overlap and ranges that lie inside the prior art establish a prima facie case of obviousness. See In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ 2d 1934 (Fed. Cir. 1990), MPEP 2144.05.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Jenkins whose telephone number is 703-306-4157. The examiner can normally be reached on M-TH6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Daniel J. Jenkins  
Primary Examiner  
Art Unit 1742

dj  
September 28, 2003